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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1958

No. — 630

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Defendant-Petitioner,

vs.

J. R. CLARK COMPANY, a corporation,
& JOHN R. CLARK,

Plaintiffs-Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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& JOHN R. CLARK,

Plaintiffs-Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above entitled case on October 10, 1958, and corrected in accordance with order entered October 16, 1958.

OPINIONS BELOW

The findings of the United States District Court for the Eastern District of Wisconsin are reported at 159 F. Supp. 948, 116 U.S.P.Q. 141. The opinion of the Court of Appeals for the Seventh Circuit is reported at 259 F. 2d 737, 119 U.S.P.Q. 161, and is reprinted in the Appendix hereto annexed.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC Sec. 1254(1) and Sec. 2101(c).

QUESTIONS PRESENTED

1. Did the Court of Appeals for the Seventh Circuit, in holding Claim 1 of the patent in suit valid and infringed, depart from the test for invention for a patented combination of old elements, to-wit, a finding by the trial court that the old elements which make up the claimed combination perform an additional and different function in combination than they perform out of it, and thereby conflicted with that rule which the Court of Appeals for the Ninth Circuit in *Kwikset Locks, Inc. v. Hillgren,* 210 F. 2d 483, at page 486, and *Bergman v. Aluminum Lock Shingle Corp. of America,* 251 F. 2d 801, 808, has held was established by this Court's decision in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. 147.

2. Did the Court of Appeals err in enlarging the scope of the claim in suit to find infringement by employing the doctrine of equivalents to construe equivocal language of the claim in suit since that doctrine is limited to preventing the practice of a fraud on a patent arising from a substitution for an element unambiguously described in a patent claim.

STATEMENT OF THIS CASE

This is a patent case involving only a single claim for an ironing table having a table top and a front and rear leg assembly for supporting the top located at an outer lateral edge of the table top.

Plaintiffs-Respondents (Clark) brought this action for infringement only of the broad first claim of the sixteen claims of Olander patent 2,663,102 (A. 131) (Note: references to record are identified as page in Joint Appendix filed herewith) for an ironing table, granted December 22, 1953 on an application filed June 9, 1950.

The structure recited in said Claim 1 (A. 142) is very simple and reads as follows:

> 1. In an ironing table having
>
> an elongated ironing board,
>
> a supporting structure for the board comprising
>
> a front leg member and a rear leg member respectively secured at longitudinally spaced points to the underside of the board and extending angularly downwardly to cross each other at a point above their longitudinal centers whereby the lower ends of the leg members will be spread further apart than their upper ends,
>
> said members consisting of single bars pivoted together at their intersection and
>
> with their parts above the intersection lying adjacent to the vertical longitudinal plane of one lateral edge of the board, and
>
> the lower ends of the leg members having rigid transverse extensions underlying the table to support the table against lateral tilting."

The District Court, after trial, without filing an opinion adopted the findings of fact and conclusions of law proposed by plaintiffs' attorneys without material change. Judgment was entered on December 19, 1957, holding Claim 1 a valid combination and infringed by the accused device. Appeal was taken to the Court of Appeals for the Seventh Circuit which affirmed the judgment of the District Court.

The Olander patent relates to ironing tables, particularly to the supporting structure for the table top. The primary objects as set forth in the patent (A. 139) are to provide a supporting structure which:

(a) firmly and rigidly supports the board;

(b) allows the operator more leg space under the board;

(c) is adjustable to regulate the elevation of the table top;

(d) may be easily collapsed against the underside of the board; and

(e) has a floor contact member which is easily detachable for shipment.

Claim 1 in suit, stripped of all formal verbiage, recites nothing more than the combination of an ironing board with single bar legs having transverse feet pivoted together at a point above their centers and with the upper portions lying adjacent to the vertical plane of one edge of the board.

Claim 1 does not recite the S-shaped legs employed in plaintiffs' Clark Model No. 10 for improving the rigidity of the supporting structure (A. 60, 61) nor does it recite a detachable foot member. The claim does not recite structure for adjusting the height of the ironing

table for stand-up and sit-down ironing, or for collapsing the leg structure flat against the table top. (A. 59, 60) As to the recited leg structure, the claim does not specify a construction to obtain room under the table, though, by the structure specified, object (b) of the five objects listed above, i.e., more leg room, is achieved.

Clark's commercial ironing table designated Model No. 10 (Pl. Ex. 10) was first displayed in January, 1953 to the public at the National Housewares Exhibit in Chicago. Defendant saw the No. 10 table at the Chicago showing and *prior to the issuance of the patent* developed the accused ironing table Model C-690 (Plaintiffs' Ex. 4 (A. 145)). The legs of the C-690 table are offset from the center of the board but not to an edge as in the Clark No. 10 table.

Claim 1 uses the term "adjacent" to define the location of the patented leg structure in respect to a lateral edge of the board. The patent specifications further state:

> "Fig. 2 is a bottom plan view of my improved ironing table with the *novel board supporting means* in collapsed position against the bottom of the board.
> * * *
>
> Fig. 10 is similar to Fig. 2 but shows a modified form of the invention with the removed foot member and the outline of a shipping carton in dotted lines." (Italics supplied) (A. 139-140)

Both Fig. 2 and Fig. 10 show that the vertical plane passing through the lateral edge of the plaintiffs' ironing board passes through a portion of the leg structure, a feature admittedly not present in any of the prior art or in the defendant's accused Model C-690, although the Mary Proctor prior art ironing board had moved the leg structure toward the lateral edge to obtain more knee

room when sitting at the board (A. 197) and it also was old to move the legs of a table slightly beyond the lateral edge. (A. 225)

The word "adjacent" means "close to" or "near to" and also means "contiguous" or "abutting". The case cited by the District Judge in Finding No. 24 (A. 121), *Johnston v. Davenport Brick & Tile Co.*, 237 F. 668, 669, contains the following quotation:

> "We realize that the word 'adjacent' does not at all times mean adjoining or abutting; but it is many times so used, and the purpose of its use is to be known from the context. Synonyms of the word are 'abutting', 'adjoining', 'attached', 'beside', 'bordering', 'close', 'contiguous', 'neighboring', 'next', and 'nigh'."

If "adjacent" be construed in the light of the specification and patent drawings, i.e., to indicate that the vertical plane passing through the outer lateral edge of the board also passes through a portion of the upper leg structure, there is no infringement. Petitioner, Geuder, Paeschke & Frey Co., developed its competitive Model C-690 ironing table and displayed it at the Atlantic City Housewares Exhibit in July, 1955 (A. 6), and commenced shipments on sales in October, 1953 (A. 13) before issuance of the patent in suit on December 22, 1953 when, for the first time, Claim 1 with the equivocal term "adjacent" to describe the location of the patented leg structure was made available to the public.

REASONS FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI

The present petitioner as well as the public in general are entitled as business men to engage in active and unfettered competition with the plaintiffs, the owner of the

patent in suit, though not entitled to infringe a valid patent claim. However, when plaintiffs' patent issued, it was manifest that Claims 2 to 16, inclusive, were not infringed by the petitioner's Model C-690 ironing table, which was then being manufactured and sold. Claim 1, the sole claim in suit, defines a conglomeration of well-known elements, and by inference only claims one of the objectives specified in the patent, to-wit, the obtaining of greater leg room by one using the said board in a sitting position. This objective is achieved from the moving of the leg structure from the central area of the ironing board to an outer lateral edge.

1. This combination claim is valid only if the elements combined perform an additional and different function in combination than they perform out of it. A specific finding to this effect is a prerequisite when a combination patent claim is involved under *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, as construed by the Court of Appeals for the Ninth Circuit in *Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483, at 486, and *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, at 808-809. No such finding was made by the trial court in this case, and the Court of Appeals for the Seventh Circuit neither followed nor commented on the construction of this court's decision by the Court of Appeals for the Ninth Circuit, which is as follows:

> "8. *In upholding the Patent, the District Court Failed to Make the Necessary Specific Finding of 'An Additional and Different Function in Combination'.*
>
> In the Kwikset Locks case, supra, 210 F. 2d at page 486, we pointed out that, in Atlantic & Pacific, supra, 'The Supreme Court further requires that in

order for a combination patent to be upheld, there must be a specific finding that the old elements which made up this device perform an additional and different function in combination, than they perform out of it.'

As in Kwikset Locks, 'No such finding was made in the case at bar.' Regardless of any other defect, such a lack makes it impossible for the present decree to be sustained." (Italics those of the Court of Appeals for the Ninth Circuit)

A mere cursory examination of the findings of the trial court (A. 115-125) and of the decision of the Court of Appeals (set forth in the Appendix to this petition) demonstrates that each, in support of the presumption of validity from issuance, leaned heavily on a long felt want and the commercial success enjoyed by the plaintiffs' Clark Model No. 10 which had numerous features, including features covered by other patents, not disclosed in the single Claim 1, here involved. Neither court attempted to find and, it is submitted, could not properly have found that the old elements which make up Claim 1 of plaintiffs' patent perform an additional and different function in combination than they performed out of it. Therefore, in view of this conflict between the Court of Appeals for the Ninth Circuit and the Court of Appeals for the Seventh Circuit, it is respectfully submitted this court should grant a writ of certiorari in this case.

2. When the plaintiffs' patent issued, the petitioner was already exhibiting and selling its Model C-690 ironing table which it had designed to compete with the plaintiffs' Clark Model 10 table.

In respect to the first claim, which alone is involved in this litigation, examination thereof disclosed that the plaintiffs had moved the leg structure described in said patent to the outer lateral edge of the table, thereby obtaining additional leg room. While prior art showed an offsetting of the leg structure from the center, no prior art showed the degree of offset employed by patentee Clark (A. 197). The word used in the claim to describe the location of this patented leg structure with reference to the outer lateral edge of the ironing board was "adjacent". Reference to any standard dictionary discloses that the term "adjacent" has two well established meanings, (1) "close to" and (2) "contiguous". In determining which meaning the patentee employed, the defendant is required to look first to the patent and the drawings. In this case Fig. 2 and Fig. 10 showed the leg structure *actually intersecting* the vertical plane passing through the outer lateral edge of the ironing table.

Moreover, patentee described this location of the leg structure shown in Fig. 2 of the patent as "the novel board supporting means in collapsed position against the bottom of the board." (A. 133; see also Fig. 10, A. 137) The leg structure in the defendant's Model C-690 is not so located. The patentee had no difficulty in describing the different location of the leg structure in defendant's accused Model C-690 ironing table, because in Claim 2 of the patent a portion of the leg structure is described as being in "a plane substantially parallel to but laterally offset from the median vertical longitudinal plane of the table." (A. 142)

As noted by the Court of Appeals for the Seventh Circuit in *Advance Rumley Co. v. John Lauson Mfg. Co.*, 275 F. 249, at 251, the patentee has the right to be his own

lexicographer and the court will unhesitatingly accept a definition of the patentee if ascertainable from the patent and if by doing so it can give better or more accurate effect to the claims. So in the instant case, the term "adjacent" in describing the location of the patented leg structure should be given a meaning consistent with the patent drawings and patentees' statement relative thereto upon which the public, including plaintiffs' competitors, must rely for the meaning of the words employed by patentee to delimit his claim.

The purpose of a patent claim is to define the addition to the stock of knowledge as to which patentee may claim a monopoly for the life of the patent. Thus also he apprises the public as to the limits beyond which they can engage in competition with the patented device without being guilty of trespass.

Moreover, when terms used in a patent claim are equivocal or ambiguous they should be limited so as to be consistent with the patentee's own statements and patent drawings. As stated by Professor Williston in his work on Contracts, Revised Edition, Volume 3, Section 621, at page 1788:

> "Since one who speaks or writes, can by exactness of expression more easily prevent mistakes in meaning, than one with whom he is dealing, doubts arising from ambiguity of language are resolved in favor of the latter."

The use by the Court of Appeals of the doctrine of equivalents which was reaffirmed in *Graver Tank & Mfg. Co., et al v. Linde Air Products Co.*, 339 U.S. 605, further illustrates the error inherent in that court's decision. The issue involves the construction of the term "adjacent". If "adjacent" means "contiguous" then there

is no infringement; if "close to", then infringement occurred if the claim is valid. The determining factor is the meaning to be given to the equivocal word "adjacent" in the light of the patentees' own statements, not whether the defendant has a competitive equivalent. To enlarge the claim under these circumstances by employing the doctrine of equivalents as a rule of construction not only avoids the constitutional test of invention but abrogates the right of a member of the public to rely on the patentees' own statements and drawings in respect to the area in which competition is not only favored but enjoined by Congressional enactments.

Under the judgment of the Court of Appeals for the Seventh Circuit the claim in suit loses all distinction from the prior art, as exemplified by the Mary Proctor board (A. 197), such that the public is denied the ability to know the limit of the patent monopoly.

CONCLUSION

In view of the foregoing, a writ of certiorari should issue to review the judgment of the Court of Appeals for the Seventh Circuit in the above entitled cause.

Respectfully submitted,

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Counsel for Petitioner

January 5, 1959

APPENDIX TO PETITION FOR WRIT OF CERTIORARI

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

OPINION OF THE

United States Court of Appeals

For the Seventh Circuit

No. 12301 SEPTEMBER TERM AND SESSION, 1958.

THE J. R. CLARK COMPANY and JOHN R. CLARK,
Plaintiffs-Appellees,
v.
GEUDER, PAESCHKE & FREY CO.,
Defendant-Appellant.

Appeal from the United States District Court for the Eastern District of Wisconsin.

October 10, 1958

(As corrected in accordance with order entered October 16, 1958)

Before DUFFY, *Chief Judge*, and FINNEGAN and KNOCH, *Circuit Judges.*

DUFFY, *Chief Judge.* This is a patent infringement suit. Claim I of Olander patent No. 2,663,102 is the only claim in issue.[1] This patent was granted December 22, 1953 on an application filed June 9, 1950. The District Court held that Claim I was valid and infringed.

[1] Claim 1 reads: In an ironing table having an elongated ironing board, a supporting structure for the board comprising a front leg member and a rear leg member respectively secured at longitudinally spaced points to the underside of the board and extending angularly downwardly to cross each other at a point above their longitudinal centers whereby the lower ends of the leg members will be spread further apart than their upper ends, said members consisting of single bars pivoted together at their intersection and with their parts above the intersection lying adjacent to the vertical longitudinal plane of one lateral edge of the board, and the lower ends of the leg members having rigid transverse extensions underlying the table to support the table against lateral tilting.

The patent in suit relates to ironing tables and is particularly directed to the supporting structure for the table top. The evidence disclosed the well-known fact that hand-ironing is a very tiring and disagreeable task for the housewife. The fatigue factor which results from hand-ironing has been the subject of scientific studies, and the industry was greatly interested in any device that would make hand-ironing less arduous.

The principal reason why hand-ironing was so tiring was that the housewife had to stand while ironing, or sit on a high stool with her knees either spread apart or twisted to one side because of the interfering leg structure of the ironing table. There are some types of ironing where the housewife prefers to stand, but usually ironing can be more comfortably accomplished while sitting, provided the table can easily be lowered to a level where the housewife can work from an ordinary chair, and provided the supporting structure is so designed that she can sit with her knees in a normal forward position and with the surface of the table brought completely over her lap so she need not bend forward while working.

Attempts were made before Olander to design ironing tables for ironing in a sitting position as is shown in patents issued to Clark, No. 2,494,506; Krueger, No. 2,566,668 and Michelson, No. 2,011,251. However, these patents did not solve the problem and there is no evidence that any tables or boards were constructed or sold which utilized the teachings of those patents.

The ironing table shown and described in the Olander patent in suit is known as Clark's Table No. 10, and is so constructed that it readily can be adjusted to various sit-down and stand-up positions to accommodate tall or short operators. The supporting structure includes pivotally connected single bar legs, the upper portions of which are disposed adjacent to the vertical plane of one lateral edge of the top. This provides knee and leg space and the top member can be positioned directly over the operator's lap. As the leg members are pivoted above their longitudinal centers, they span a wide floor area, and this forms a rigid supporting structure regardless of the elevation to which the table is adjusted. Another feature of the Clark Table No. 10 is that the entire supporting structure is collapsible

flatly against the underside of the ironing table for shipment or storage.

Olander filed his application in June, 1950, and the corporate plaintiff[2] made immediate plans to go into production and build up an inventory. The ironing table was first displayed to the public at the National Housewares Exhibit held in Chicago in January, 1953. The President and the Sales Manager of defendant each saw and examined plaintiffs' table and caused one to be purchased by defendant.

The design engineer of defendant was instructed to build an ironing table in competition with Clark's Table No. 10. The ironing table which was thereafter developed by defendant was known as Model C-690. Starting in June, 1953, this table was widely advertised, and was first sold by defendant in October, 1953. In its advertisements appearing in nationally distributed publications, defendant's Model C-690 was described as "sensational" and as a "radically new design." Model C-690 became defendant's most popular table in its high-priced line and completely displaced defendant's previous deluxe ironing table Model C-680. The accused structure is defendant's Model C-690.

Clark's Model No. 10 embodied the structure defined by Claim I. It also incorporated a diagonally crosswise leg structure contained in plaintiffs' companion patent, Olander No. 2,663,101 which was issued the same day as the patent in suit. This new model met with great commercial success. By September 30, 1956, more than a million of such ironing tables had been sold. For the first fiscal year after Model 10 was placed on the market, the sales were four times as great as the number of plaintiff's sales of its previous deluxe ironing table for a like period. Furthermore, Model 10 sold at a considerably higher price than any previous model of ironing table sold by plaintiffs.

Defendant argues that Claim I is invalid in that it reads upon the prior art and the Mary Proctor ironing table. The Mary Proctor Hi-Lo sit-down or stand-up ironing table was made by Proctor Electric Company and was

[2] Hereinafter, a reference to plaintiff will mean the corporate plaintiff.

offered for sale August 25, 1949. The principal prior art relied upon by defendant is Lowenberg Patent No. 1,976,031.

Lowenberg is a file wrapper reference and was considered by the patent office examiner. Lowenberg was a combination card table and bedside table. This structure was not intended as a solution of the problems involved in ironing clothes. The legs of the Lowenberg table are not pivotally connected at points above their longitudinal centers. These legs are not collapsibly arranged to perform the functions required in an ironing table. We agree with the District Court that the examiner who allowed the claim in suit was correct in rejecting Lowenberg as not being a pertinent reference.

We likewise agree with the statement of the District Judge that the Mary Proctor ironing table "not only does not suggest the invention of the patent in suit, but that as far as the structure defined by the Olander claim is concerned, the Mary Proctor ironing table is substantially identical with the Hild patent, No. 2,546,097, which the examiner considered and rejected, and is substantially identical with the Model C-680 ironing table which defendant previously sold and which was displaced by the infringing Model C-690 ironing table." This statement is substantially correct in spite of the fact that the legs of the C-680 table are located on center and the legs of the Mary Proctor table are located off center.

The claim in suit was allowed over the following prior art cited by the examiner: Tucker, 264,049; Northrup, 1,161,407; Reed, 1,359,527; Gomber, 1,801,151; Lowenberg, 1,976,031; Miller, 2,517,696; Hild, 2,546,097.

In addition to Lowenberg, defendant now cites and relies upon Busch No. 863,150 and Pope No. 1,098,682. We think Busch and Pope are no more pertinent to the invention shown by the claim in issue than references of record in the Olander file wrapper.

Oral testimony on the trial emphasized that Clark No. 10 Table which embodies the teachings of Claim I, was new and novel, and was a contribution to the art. Kleinsorge, who had forty years' experience in the ironing table business and was not connected with either party, testified

that the present invention was a "tremendous step forward in solving the problem," and that "it jarred the entire industry when they saw this table. I know it did me." Even defendant's sales manager, Stephany, testified: "I recall that it was one of the probably outstanding ironing tables or new ideas in ironing tables." Stephany also admitted that Clark Table No. 10 "* * may have speeded up our thinking on the problem * * * defendant had never thought of the C-690 until after we saw the Clark exhibit at the January 1953 Show."

We need say nothing further as to the prior art except to quote with approval Finding of Fact 23: "None of the prior art disclosures here in evidence in any way anticipates, nor does it show lack of invention in, the structure defined by Claim I of the patent in suit, nor would any of such disclosures have suggested the improved ironing table of said Claim I to a person skilled in the art at the time of the invention thereof by Olander."

The District Court found there was no file wrapper estoppel. On this appeal, defendant says it is not claiming file wrapper estoppel but does urge that the presumption of validity of Claim I does not apply to the Lowenberg file wrapper reference because of the conduct of the patentee in the prosecution of the application. Olander had rewritten Claim 15 as Claim 34 which claim, in turn became Claim I in suit. Defendant urges in effect that Claim I was allowed by oversight of the examiner. We think the prosecution of the Olander application followed normal procedure. There is nothing to indicate the examiner was not fully cognizant of the scope of Claim I.

We now reach the question of alleged infringement. Defendant brought out its table, C-690, only after its principal officers and certain of its employees had the benefit of a detailed inspection and study of plaintiff's Table No. 10. It is quite apparent that defendant endeavored to invent around the invention disclosed in the Clark Table. That defendant succeeded to a considerable degree may be inferred from the fact that of the sixteen claims of the patent in suit, only Claim I is alleged to be infringed by defendant's table.

Defendant's argument that Claim I was not infringed revolves about the word "adjacent" as used in said Claim,

to-wit: "* * * said (leg) members consisting of single bars pivoted together at their intersection and with their parts above the intersection lying *adjacent* to the vertical longitudinal plane of one lateral edge of the board * * *." Defendant argues that "adjacent" means "touching" and explains that in its structure there is a space of one inch between the outer edge of its board and the front leg of defendant's table.

Defendant urges that the word "adjacent" must be interpreted in the light of the specification. We find in the specification that the main position of the front leg 17 is described as being "in a vertical plane substantially coincident with the outer lateral edge of the board 16." Defendant strongly insists that the space of one inch between the leg member and the outer edge of its table prevents it from being "adjacent" or "substantially coincident" with said vertical plane.

The question of infringement is closer than the question of validity. However, we have concluded that the District Court was correct in its finding of infringement. A significant part of the specification hereinbefore described is the word "substantially." There is certainly more flexibility in the words "substantially coincident" than if the word "coincident" had been used alone.

Dimensions are not given in the patent, but in Clark Table No. 10 which is proportionately the same as in the patent drawing, the top is fourteen and a half inches wide, and the two single bar legs are of such thickness and so located as to leave eleven and a half inches of knee room under the operator's side of the board. In defendant's table, C-690, the leg bars are set in one inch from the front edge of the board, but a fifteen inch top member is employed. The result is that there are eleven and one-eighth inches of knee room for the operator. Practically the same result is achieved for there is only three-eighths of an inch difference in knee room or leg space between the two tables.

Pertinent here is language in the Supreme Court opinion in *Graver Tank & Mfg. Co., Inc. et al.* v. *Linde Air Products Co.*, 339 U.S. 605, 607:

"Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. * * *"

The opinion continues, page 608:

"The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. * * * 'To temper unsparing logic and prevent an infringer from stealing the benefit of an invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'"

We think there is substantial evidence to sustain the finding of the District Court that defendant's Model C-690 ironing table embodies many of the structural and functional advantages set forth in the Olander patent. The trial court was justified in finding that they are the same in essence and substance and consequently that Model C-690 ironing table infringes the claim in suit. Judgment

AFFIRMED.

A true Copy:

Teste:

.....

Clerk of the United States Court of Appeals for the Seventh Circuit.

JUDGMENT

United States Court of Appeals

For the Seventh Circuit

Chicago 10, Illinois

Friday, October 10, 1958

Before

Hon. F. Ryan Duffy, Chief Judge,

Hon. Philip J. Finnegan, Circuit Judge,

Hon. Win G. Knoch, Circuit Judge.

THE J. R. CLARK COMPANY and JOHN R. CLARK,
Plaintiffs-Appellees,
v.
GEUDER, PAESCHKE & FREY CO.,
Defendant-Appellant.

Appeal No. 12301

This cause came on to be heard on the transcript of the record from the United States District Court for the Eastern District of Wisconsin and was argued by counsel.

On consideration whereof it is ordered and adjudged by this Court that the Judgment of the said District Court in this cause appealed from be and the same is hereby affirmed with costs.

FILE COPY

Office-Supreme Court, U.S.
FILED
JAN 22 1959
JAMES R. BROWNING, Clerk

In the Supreme Court of the United States

OCTOBER TERM 1958

No. 630

GEUDER, PAESCHKE & FREY CO., A CORPORATION
Defendant-Petitioner

vs.

THE J. R. CLARK COMPANY, A CORPORATION, AND JOHN R. CLARK
Plaintiffs-Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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In the
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OCTOBER TERM 1958
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GEUDER, PAESCHKE & FREY CO., A CORPORATION
Defendant-Petitioner

vs.

THE J. R. CLARK COMPANY, A CORPORATION, AND JOHN R. CLARK
Plaintiffs-Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

FOREWORD

Respondents take no issue with respect to petitioner's statements concerning identification of the *Decisions Below* or of presently invoked *Jurisdiction*.

Respondents deny that the *"Questions Presented"*, stated in the Petition (p. 2) are present in the case, and challenge the *Statement Of This Case* (pp. 2-6) as well as the alleged *Reasons For Granting The Petition For Writ Of Certiorari* (pp. 6-11), as presented by petitioner.

RESPONDENTS' STATEMENT OF THE CASE

Under this Court's Rule 19, 1. review on writ of certiorari "will be granted only where there are special and important reasons therefor".

This is a conventional patent suit in which the petitioner, defendant below, ostensibly seeks a hearing by this Court on conventional patent questions of validity and infringement, whereas the real objective is apparently no more than to delay the final accounting and money damages to which the lower courts have unequivocally found respondents entitled.

The petitioner's contention that there is conflict between decisions of the Courts of Appeal for the Seventh and Ninth Circuits, on issues involved in this case, and for the purpose of invoking review under this Court's Rule 19, 1.(b), is without substance or merit, as will hereinafter be shown.

This action was brought May 12, 1954, and following interrogatories, the taking of depositions, and pre-trial conferences and briefs, a full trial was had in January, 1957. After additional briefing, and oral arguments, the trial court found for plaintiffs-respondents on all issues, the formal Judgment (A-126-7) being entered on December 19, 1957.

The Judgment decreed claim 1 of the Olander patent in suit to be valid and infringed, and awarded plaintiffs a perpetual injunction against defendant, as well as full recovery for profits and damages, with costs, etc.

The Writ of Permanent Injunction was issued January 6, 1958, and is presently still in effect since no staying supersedeas was filed.

The Opinion of the Court of Appeals for the Seventh Circuit, written by Chief Judge Duffy, and its Judgment, affirming the trial court, were entered October 10, 1958. The present Petition for Writ of Certiorari was filed a few days within the three months permitted under the statute and that without attempting to stay the Mandate.

Petitioner's factual representation of evidence, as given in the "*Statement Of This Case*" (pp. 4-6), is improper and misleading because it is argumentative and distorts or omits facts which must be recognized and accepted for purpose of this Petition. Thus—

(1) The Olander patent claim in suit, as corrected by Certificate of Correction, is the definition of invention that is relied on, both for validity and infringement. It must stand or fall on the language and wording found within itself, and as stated in the trial court's Finding No. 2 (A-115).

Petitioner's fact contention (p. 4) that the claim in suit when—

> "stripped of all formal verbiage, recites nothing more than the combination of an ironing board with single bar legs having transverse feet pivoted together at a point above their centers and with the upper portions lying adjacent to the vertical plane of one edge of the board."

is accordingly nothing less than a deliberate effort to substitute its own ambiguous and misleading interpretation of subject matter for that set forth in the claim. Thus, and entirely aside from various omissions, the above quoted language suggests that it may be the "feet" rather than the "bar legs" that are "pivoted together" and does not say *what* it is that has "upper portions lying adjacent to, etc."

So, too, petitioner (p. 4) lifts expressions (a) to (e) from specification context, and then apparently attacks validity on a theory that the stated "primary objects" should have been recited in the claim itself.

By petitioner's first interpretation the claim, "stripped of all formal verbiage", could be reduced to but a few words,

while the alternate conception would necessitate inclusion of a substantial part of the specification. Either would be very different from the claim as it is, and there is no justification for thus misleading this Honorable Court on a fact presentation which is clear in the patent itself and with which the lower courts had no problem.

(2) Petitioner admits (p. 5) that it (its officers) saw the Clark Model No. 10 ironing table when it was first displayed in January, 1953 at the National Housewares Exhibit in Chicago. Such admission, or the contention that defendant developed the accused Model C-690 prior to granting of the patent, are per se, clearly of no importance as far as any issues of this case are concerned.

The January, 1953 showing did, however, give rise to factual considerations that were extremely important to critical issues in this case, and as to them the present Petition is ominously silent.

Display of the No. 10 table at the Chicago Exhibit was extremely significant because of its impact on the industry and particularly on the defendant. This is reflected in the trial court's Findings 12 to 17, inclusive, in which it is made clear that the Olander invention was not only of radically different design, but that it solved a serious problem of long standing. Also that defendant immediately took steps to make and sell the infringing ironing table which was then characterized in the trade as being sensationally new.

(3). Other important facts which the petitioner conveniently omits include (a) the undisputed and uncontested Finding (No. 6, p. 116) that hand ironing is one of the most tiring, disagreeable and frustrating tasks of the housewife, that the fatigue factor has been the subject of scien-

tific studies, and that a great deal of thought and effort has been expended in solving this problem. (b) That (F. of F. 8, 9 and 10) the problem had existed for years and earlier attempts to solve it had failed. (c) That Olander's invention did solve the problem (F. of F. 11) and when placed on the market by both petitioner and respondent it completely displaced the previous deluxe models sold by both companies (F. of F. 16, 17, 18 and 27). (d) Finally that the Olander device was inventive and patentable over all prior art devices cited either in the Patent Office or by the defendant-petitioner (F. of F. 19, 20, 21, 22, 23 and 28).

(4) On the issue of infringement petitioner represents as a fact (p. 5) that "The *legs* of the C-690 table are offset from the center of the board but *not to an edge as in the Clark No. 10 table.*" This is misleading. As clearly shown in Fig. 2 (A. 133) only one leg (21) is offset to an edge of the board. The other leg bar 30 is inwardly thereof. This is clarified by the specification wherein the part 21 is described as being in "a vertical plane substantially coincident with the outer lateral edge of the board" (A. 140, Col. 3, lines 46-48), while the portion 30 of leg 18 is described as being in a plane "adjacent to and parallel with the vertical plane in which the leg portion 21 lies" (A. 140, Col. 4, lines 7-10).

On this showing the trial court concluded that the word "adjacent" was properly used to describe the relationship of both bars with respect to the vertical plane passing through one edge of the board, that it applied equally to both plaintiffs' and defendant's tables, and that the use of "adjacent" in a patent claim had been sanctioned and approved by judicial interpretation in given published decisions (F. of F. 24, A. 121).

The foregoing explanation is made merely to correct the erroneous fact presentation in the petition, and not because it has even a remote bearing on whether or not certiorari should be granted, for clearly it does not.

ARGUMENT

Petitioner's alleged reasons for seeking review are completely without merit.

The Petition is barren of any credible reason or argument for justifying certiorari.

(1) Respondents take no issue with petitioner's opening assertion (pp. 6-7) that petitioner and the public are entitled to engage in unfettered competition with plaintiff "though not entitled to infringe a valid patent claim."

(2) The implication (p. 7) that petitioner should escape liability because respondent only relied on one of several claims in the Olander patent is wholly without merit as is self-evident.

(3) The statement (p. 7) that the "objective" inferentially found in claim 1 "is achieved from the moving of the leg structure from the central area of the ironing board to an outer lateral edge" is grossly misleading because it erroneously suggests that there is a prior art structure having a leg structure which if so moved would meet the claim. There is definitely no such prior art structure here in evidence.

The extension of this argument, as found on pages 9 and 10 of the Petition adds nothing to its weight, and obviously the language quoted from claim 2 of the patent (not here in suit) can in no wise alter the scope or meaning of claim 1.

(4) Petitioner's characterization (p. 7) of claim 1 as defining nothing more than "a conglomeration of well known elements" is in brazen disregard of its own testimony (F. of F. 16 and 17) to the effect that the infringing table which it made was "the most efficient and best ironing table" it ever produced and when marketed became a "sensational" success completely displacing petitioner's previous best model.

(5) Reason 2 (p. 8) advanced by petitioner is that when the Olander patent issued "petitioner was already exhibiting and selling its Model C-690 ironing table which it had designed to compete with the plaintiffs' Clark Model 10 table." This fact is conceded but on what theory such fact can affect the issues in this case and particularly to form a basis for certiorari is not explained and is incomprehensible.

(6) The argument (p. 11) that under the judgment of the Court of Appeals "the claim in suit loses all distinction from the prior art as exemplified by the Mary Proctor board" apparently now limits reliance on prior art to that board but in any event flies into the teeth of uncontroverted facts. The first is that petitioner has not heretofore relied solely on Mary Proctor for anticipation, because it clearly does not meet the claim. Secondly, the trial judge specifically found (a) that the Mary Proctor "did not solve the problem that was solved by the Olander invention" (F. of F. 10, A. 117); and (b) that Mary Proctor "does not (even) suggest the invention of the patent in suit" from which it was as distinguishable as the Hild patent, rejected by the examiner, and as the Model C-680, which petitioner had discontinued (F. of F. 22, A. 120-121). These are findings which the Court of Appeals specifically affirmed

(Opinion p. A-4), and in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 64 S. Ct. 593, 594 this Honorable Court said "It must be a strong case in which this court will set aside these concurrent findings of two courts" (1944).

(7) Turning next to the alleged "conflict between decisions" petitioner's position (pp. 7-8) is equally untenable. The contention that either the original findings (A. 115-123), or the subsequent decision by the Court of Appeals for the Seventh Circuit are inconsistent with the Supreme Court decision in the *A. & P.* case (*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 240 U. S. 147, 71 S. Ct. 127), as construed by the Court of Appeals for the Ninth Circuit in *Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483, and *Bergman v. Aluminum Lock*, 251 F. 2d 801, is sheer fiction, and gives rise to what can only be considered moot questions at best.

By pre-trial agreement of the parties, concurred in by the trial judge, the issues in this case were closely restricted to certain questions of fact and law (F. of F. 4). Those issues were then decided, and in considerable detail, in favor of respondent (A. 116-125). In like manner the Court of Appeals affirmed (259 F. 2d 737). That is all that either court was required to do.

Nor can such concurrent findings be said to fall short of the requirements in the *A. & P.* case, regardless of how or by what court they may be construed. Thus the findings (6, 8, 9, 10, 19, 20, 22) review the problems involved, and the efforts and failures by others to solve those problems.

The Olander ironing table is then described (F. of F. 11) as being "so constructed that it can be readily adjusted

to" perform several specific functions (F. of F. 7), the need for which had long been known, but which are not found in any single prior art device (F. of F. 19, 20, 21, 22 and 23). These findings are all affirmed and in fact supplemented by still more specific observations as to the structural and functional distinctions and advantages over the prior art.

In sustaining the claim in suit the Court of Appeals for the Seventh Circuit not only pointed out why it considered the Olander invention patentably distinguishable from the prior art, and a valuable contribution, but did so in a manner that clearly distinguishes this case from the three decisions relied upon by petitioner.

Thus, in the *A. & P.* case this Court's decision did not turn on academic prerequisites of claim language or findings, but rather on whether or not there existed "invention only in an extension of the (a) counter." The answer was negative because there was no "unusual or surprising consequences from the unification of the elements", and because the combination did not as a "whole in some way exceed the sum of its parts."

In the *Kwikset Locks* case the claims in question were not held invalid because of any deficiency in the trial court's findings, but because and only because that court had "failed to apply the strict standard for testing combination patents." In the lengthy *Bergman* decision the patent covered a mere drain slot in a shingle, which the court regarded as "at most—merely a mincing step forward." It did cite its earlier *Kwikset* decision in connection with a similar omission of finding, but this was *obiter dictum*, as the final holding was "invalid for want of novelty and invention" (p. 809).

In the present case the claim defines what the lower courts recognized as a completely new, novel and patentable combination of parts or elements, all so constructed and arranged as to solve an old, serious problem. The findings here of record, like those before this Court in *Williams Mfg. Co. v. United Shoe Mach. Co.*, 316 U. S. 364, 62 S. Ct. 1179 (at 1181)—

> "are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way to produce an improved result. * * * The claim that the combinations are merely of old elements, which perform no new function and produce no new result, must be overruled."

CONCLUSION

The ironing table, today as in the past, stands as a symbol for tiring and disagreeable work. To the extent that the Olander invention has made that task easier and less disagreeable this case is important. To the extent that issues are presented of sufficient weight and consequence to justify the intervention of this Honorable Court this case is of no importance.

The Petition for Writ of Certiorari should accordingly be denied.

Respectfully submitted,

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NOTICE OF SERVICE

This is to certify that five copies of this brief have been served on Mr. Maxwell H. Herriott, counsel for petitioner, by mailing the same to him at his last known address, postage prepaid, this — day of January, 1959.

ANDREW E. CARLSEN.

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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1958

No. 630

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Defendant-Petitioner,

vs.

J. R. CLARK COMPANY, a corporation,
& JOHN R. CLARK,

Plaintiffs-Respondents.

PETITIONER'S REPLY

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PETITIONER'S REPLY

The Petition herein was based upon two grounds, neither of which is refuted or met by Respondents.

1. The interpretation of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, by the Ninth Circuit Court of Appeals, i.e., that " * * * there must be a specific finding that the old elements which made up this device perform an additional and different function in combination, than they perform out of * * * " the claimed combination, was expressed as a positive ground for the decisions in *Kwikset Locks Inc. v. Hillgren*, 240 F. 2d 483, and *Bergman v. Aluminum Lock*

Shingle Corp. of America, 251 F. 2d 801. No such finding was made in the present case.

The pre-trial Stipulation (F. of F. 4, A. 116) limited the issue of infringement to Claim 1 and the test of validity to certain specific prior art. Validity was in issue, and if the Ninth Circuit is to be followed, the specific combination of Claim 1 as to validity would have to be measured as to the new function of its elements (not the elements of the other claims, or other elements disclosed but not included in the claim).

The several alleged advantages of the ironing table of the patent in suit as found by the trial court (F. of F. 7, 11, A. 116, 117) and as mentioned in the patent (A. 139) comprise adjustment of height for sit down and stand up ironing, rigidity, collapsibility, leg room beneath the board, automatic adjustment of height, and a detachable floor contact member. The recital of Claim 1 does not produce the said advantages by virtue of the elements combined therein, namely single bar legs pivoted at their intersection and having portions above the intersection lying adjacent to the plane of one edge of the board. More leg room may result from the offset of the legs from the center of the table, but this is not a new feature giving rise to a new function. Ironing table legs had been offset in the Mary Proctor stand-up and sit down table (A. 197) and in Lowenberg (A. 225), not an ironing table but admitted by the patentee Olander to be "in a closely related art" (A. 202), the offset was carried beyond the edge of the table and room obtained thereunder as a bedside table.

The trial court did not and could not make a finding of a new function for the elements of Claim 1. Further, Respondents' attempt to construe the findings as a com-

pliance with this Court's decision in no way negatives the conflict between the Circuits, but rather magnifies it.

2. The term "adjacent" used in Claim 1 to specify the position of the leg structure, so as to distinguish from the prior art and advise the public as to the area of monopoly, must be construed in light of both the relevance of the prior art and the patentee's representations in his specification and drawings. (This issue is not one that merely deals with validity, as Respondents treat it in their argument (page 7, para. (6), but raises the question of how the public is to determine the breadth of the claim in suit).

It is not proper to resolve the issue of validity and presence of invention by reference to patentee's table as a whole (those elements which are covered by all the Claims 1-16 and are described in the specification), and then after such determination independently to decide whether the few elements of Claim 1 may be infringed by resort to a broadening of its language. This constitutes a double standard that may save a broad or incomplete claim, and then establish infringement by a device that resembles the prior art rather than a literal reading of the claim. The application of the doctrine of equivalents in this case to broadly construe "adjacent", after first finding invention in the complete table, enables the patentee to avoid specific application of the prior art to Claim 1. As a result the public is unable to determine the manner in which it may compete. The essence of the patent system to encourage and foster disclosure of a patentee's contribution, so as to promote progress of the arts, thereby becomes emasculated.

CONCLUSION.

Respondents have not negatived the grounds for a Writ of Certiorari and such Writ should issue to review the judgment of the Court of Appeals for the Seventh Circuit in the above entitled cause.

Respectfully submitted,

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January 28, 1959

NOTICE OF SERVICE

This is to certify that five copies of this Brief have been served on Mr. Andrew E. Carlsen, counsel for Respondents, by mailing the same to him at his last known address, postage prepaid, this 28th day of January, 1959.

Maxwell H. Herriott